

*AOI
Cancelled*
label or literature at the time of sale which represents that the carpet is recyclable without segregation of carpet components.

REMARKS

Claims 1-6, 9-12 and 15-17 are pending. Claim 9 has been amended to address the deficiencies noted in the January 15 Office Action. Additionally, in the interest of advancing prosecution of this application, Applicants are addressing herein the rejections and other matters set forth in the January 15 Office Action.

A courtesy copy of the claims as currently pending herewith is included to assist in further review of this application.

Applicants respectfully request that the Examiner contact the undersigned if it is believed that, after review of the matters stated herein, any outstanding issues regarding this application may be resolved *via* an interview with the undersigned.

I. Comments Regarding Examiner's Response to Arguments

In paragraphs 9 and 10 of the January 15 Office Action, the Examiner addressed Applicants' arguments regarding the Parikh reference (U.S. Patent No. 6,344,515 B1) inasmuch as those arguments were considered to be relevant to the present rejection over Parikh.¹

In paragraph 10, with reference to column 21, lines 1-13 of Parikh, the January 15 Office Action stated:

Parikh explicitly teaches one embodiment of the invention is an extruded hot melt adhesive for a carpet backing.

Applicants respectfully state that this statement is an incorrect reading of Parikh.

To the contrary, the excerpted portion of Parikh in the January 15 Office Action does not support the contention that the adhesive materials of Parikh can be used as adhesive materials for carpet backing as recited in the claims. Indeed, Parikh states:

the compositions may be readily extruded onto a variety of substrates, including but not limited to carpet backing, flooring tiles and sheets, and woven and non-woven backing.

¹ Applicants' traversal of the new rejections presented in the Office Action is discussed in detail below.

ATTORNEY DOCKET NO. 19133.0029U2
Application No. 09/032,893

(Parikh, col. 21, lines 8-11 emphasis added.) Taken in the context of this description, one of ordinary skill in the art would not find from this disclosure that the Parikh adhesive could be used as an adhesive material as recited in the claims. Rather, from this disclosure one of ordinary skill in the art would understand that the adhesive of Parikh can be placed onto the back of an already-prepared carpet backing. Put another way, taken for what the reference fairly describes to one of ordinary skill in the art, Parikh discloses only that its adhesive materials may be used to provide an adhesive backing for an already-formed structure, not that Parikh's materials may be used as an adhesive backing material as claimed. Accordingly, Parikh does not support a rejection of the claims under § 103 for at least this reason. *See In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965) ("It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."); *see also Bausch and Lomb, Inc. v. Barnes/Hind Hydrocurve, Inc.*, 230 U.S.P.Q. 416, 419-420 (Fed. Cir. 1986) (stating that it is improper to isolate certain aspects of a reference to support a rejection without considering the teaching of the reference as a whole.)

Further, Applicants respectfully disagree with the statement in paragraph 10 of the January 15 Office Action that "Parikh explicitly teaches one embodiment of the invention is an extruded hot melt adhesive for carpet backing." The examples referred to for this alleged explicit teaching are adhesive materials that do not contain adhesive materials as claimed by Applicants *i.e.*, homogenously branched ethylene polymers ("HBEP"). Instead, these adhesives are made from styrene-ethylene interpolymers (*See Examples 2-8 and Examples 21-23.*) Further, the efficiency of these adhesives is measured for peel strength values when used as adhesives for aluminum or stainless steel (*see Tables 4 and 7*), thus indicating that these materials are functioning as surface adhesives. Thus, it is respectfully contended that the noted examples do not suggest or motivate in any way that the adhesives of Parikh can be used as adhesive materials for carpets as claimed in the present invention.

In light of the above, Applicants respectfully assert that there is no support for the reading of Parikh as disclosing an adhesive for carpet backings as claimed. Put another way, there is

ATTORNEY DOCKET NO. 19133.0029U2
Application No. 09/032,893

nothing in Parikh to suggest that the adhesive materials would provide, *inter alia*, "an adhesive backing material, wherein the adhesive backing has substantially penetrated and substantially consolidated the fibers...wherein the adhesive backing material is not integrally fused to the primary backing material, and wherein the carpet has a tuft bind of 5 pounds or more as measured according to ASTM D1335-67." (See claim 1 as pending.)

II. Rejections of Claims 1-6, 9-12, and 15-16

The January 15 Office Action has stated new grounds of rejection for claims 1-6, 9-12 and 15-16 wherein these claims are alleged to be unpatentable over Parikh.

a. The Official Notice Taken In the January 15 Office Action Is Improper.

As an initial matter, in paragraph 7 the January 15 Office Action purports to take Official Notice that the face, primary backing and adhesive aspects of the invention are allegedly well-known in the art. The scope of this Official Notice involves a significant aspect of the claimed invention and, as such, exceeds the recognized reason for the allowing of Official Notice. In particular:

[Official Notice] fills the gaps which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. We know of no case in which facts judicially noticed comprised the principal evidence upon which a rejection was based or were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used.

In re Ahlert and Kruger, 165 U.S.P.Q. 418, 421 (C.C.P.A. 1970). Not only does the Official Notice taken in the January 15 Office Action comprise the principal evidence against the claims, that is, it forms the primary grounds for rejection with which the adhesive disclosure of Parikh is combined, but this Official Notice also constitutes a new ground of rejection when combined with the previously used Parikh reference. In light of the admonition in the above excepted case, Applicants respectfully state that the Official Notice taken in the January 15 Office Action is improper.

Moreover, the basis for the Official Notice set forth in the January 15 Office Action appears to be based upon the personal knowledge of the Examiner. Should the rejection based on the statement of Official Notice be maintained, Applicants respectfully request that the facts alleged to form the basis of this personal knowledge be stated as specifically as possible in an

Examiner's affidavit so that Applicants be accorded their opportunity to rebut this information.

See M.P.E.P. 2144.03.

b. **No Prima Facie Case Of Obviousness Has Been Presented.**

Notwithstanding that the January 15 Office Action has not properly demonstrated that the face, primary backing and adhesive aspects of the claimed invention are present in the prior art and that such prior art suggests or motivates use of the adhesive disclosed by Parikh, it is contended in paragraph 7 of the January 15 Office Action that Parikh contains "explicit teachings to produce a carpet with the inventive adhesive composition." As discussed in detail above, there is nothing in the disclosure of Parikh that indicates that the adhesive material therein could be used as contended in the January 15 Office Action. To the contrary, the only manner in which HBEP adhesive materials are disclosed in Parikh is as one of several noted "extending or modifying composition[s]." (See Parikh, col. 14, lines 31-51.) Further, Parikh does not suggest that HBEP may be used without the other adhesive materials that form the main adhesive formulations of Parikh. To the contrary, Parikh indicates that HBEP should be used "to extend the composition when the composition comprises a substantially random interpolymer which has a high styrene content, and to improve the lack of modulus of the adhesive when the adhesive comprises a substantially random interpolymer which has a low styrene content." (Parikh, col. 14, lines 46-51.) Parikh not only does not suggest that the adhesive therein could be used as claimed, this reference teaches away from the use of HBEP materials without the main adhesive components, *i.e.*, styrene, disclosed in Parikh.

Moreover, in paragraph 7, the January 15 Office Action asserts that:

a conventional polyolefin carpet having the inventive Parikh composition would inherently possess the presently claimed tuft bind strength since said carpet meets all the structural and chemical limitations of the claims.

Again, as discussed in detail above, Parikh does not disclose or suggest in any manner that the adhesive disclosed therein may be used as claimed by Applicants. Put another way, the January 15 Office Action has not demonstrated that "conventional polyolefin carpet"² coated with the

² To the extent the January 15 Office Action is contending that the claimed invention is a "conventional polyolefin carpet," Applicants object to such a characterization.

adhesive of Parikh would necessarily possess the features as claimed. Thus, Applicants respectfully contend that the January 15 Office Action has not met its burden of presenting a *prima facie* case of obviousness of claims 1-6, 15 and 16. As such, contrary to the statements in the January 15 Office Action, Applicants state that the burden has not shifted to them to prove that a carpet coated with the adhesive of Parikh would not inherently possess the features claimed in the present invention.

To the extent the January 15 Office Action contends that the features of the claimed invention are inherent in the prior art, Applicants respectfully state that the Office Action does not present proper grounds for such an inherency rejection in that there is no presentation of “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Additionally, although the January 15 Office Action contends (improperly) that the tuft bind element of the claims is met inherently, the rejection wholly fails to address the recited claim elements of substantial penetration and consolidation, nor does it address the recitation that the adhesive backing material is not integrally fused to the primary backing material. The absence of any reference to these recited elements in the rejections presented in the January 15 Office Action results in the rejections being improper under § 103(a). *See In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1970) (stating that all claim limitations must be taught or suggested by the prior art.)

Further, with respect to claims 9-12, to the extent the rejection of these claims is based on the disclosure of Parikh, these rejections are improper also.

c. **Rejection of Claim 17**

The Office Action contends that claim 17 is obvious under 103(a) over the cited Parikh reference in view of U.S. Patent No. 5,741,594 issued to Jialanella.

ATTORNEY DOCKET NO. 19133.0029U2
Application No. 09/032,893

As discussed in detail above, Parikh does not suggest or motivate the claimed invention. Therefore, regardless of what Jialanella does or does not disclose,³ Parikh does not operate as a proper primary reference against the claimed invention and the rejection of claim 17 is improper.

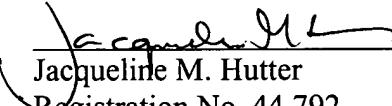
CONCLUSION

In light of the above Amendment and Remarks presented herein, it is respectfully contended that the rejections stated in the January 15 Office Action have been overcome and the other matters stated therein have been addressed. As such, it is believed that the application is in condition for allowance.

The RCE filing fee is included herewith. No additional fee is believed to be due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, or to credit any overpayment, to Deposit Account No. 14-0629.

Respectfully submitted,

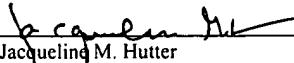
NEEDLE & ROSENBERG, P.C.


Jacqueline M. Hutter
Registration No. 44,792

NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(404) 688-0770
(404) 688-9880 (Fax)

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.


Jacqueline M. Hutter

4113183
Date

³ To the extent necessary to preserve their rights on appeal, Applicants respectfully disagree that they "asserted" that Jialanella discloses a secondary backing. Rather, Applicants stated in the indicated Request for Reconsideration that "if Jialanella's laminated are used in carpet backings, they could only serve as secondary carpet backings; and adhesive functionality would have to be provided by another material." (See July 25, 2002 Request for Reconsideration at page 3.)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

9. The carpet of Claim 1 wherein (i) the fibers, primary backing[,] and adhesive backing [and optional secondary backing] all comprise a polyolefin polymer, (ii) the olefin monomer chemistry of the adhesive backing differs from that of the fibers and the primary backing, and (iii) the carpet includes a label or literature at the time of sale represents that the carpet is recyclable without segregation of carpet components.